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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

WITZENBURG, BRUCE A

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/590,330	Applicant(s) LITWIN ET AL.	
	Examiner BRUCE A. WITZENBURG	Art Unit 2166	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-16,18 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-16,18 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Responsive to applicant's amendments dated 3/26/2008, claims 1, 4-16, 18, and 20 remain pending in this application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 4-5, and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agrawal in view of Rosenschein et al. (US 6,341,306) hereafter Rosenschein.

Regarding claim 1, Agrawal discloses A method for organizing e-mail messages (Abs) comprising the steps of:

indicating at least one first e-mail message in a user mailbox; (Col 1, line 66 – Col 2, line 3)

associating the at least one first e-mail with a second e-mail by user-enablement of an association option (Col 2, lines 2-11 and Col 2, lines 38-41);

selecting an associate option (Col 2, lines 22-30 and Col 7, lines 57-64);

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and indicating the second e-mail (Col 2, lines 22-30 and Col 7, lines 57-64 Note it is inherent in the implementation that in order to associate the document that it must be indicated and selected in some manner in order to move the document);

selecting a second email, wherein the second e-mail is caused to be automatically associated to the at least one first e-mail to form the associated group (Col 2, lines 8-11),

and forming an associated group of e-mails in the user mailbox comprising at least two or more associated e-mails (Col 2, lines 38-41),

creating a reply email to at least one of the associated groups of emails; (note that while Agrawal does not specifically disclose creating a reply email, it does disclose associating groups based on topics and it would have been obvious to one of ordinary skill in the art at the time of the invention to include all addresses interested in the above topic in creation of a reply email. Further note the instant application does not limit the manner in which the reply email is created and thus even manual creation reads on the claimed language)

selecting at least one of the show associations option and the hide associations option for the reply e-mail to control whether the reply e-mail is to show information on its associations to a recipient. (While Agrawal does not specifically disclose a show or hide associations list regarding outgoing mail, CC - or carbon copy and BCC - or blind carbon copy are well known in the art at the time of the invention which show or hide other email addresses associated with the outgoing mail and it would have been obvious to one of ordinary skill in the art at the time of the invention to use such email

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fields. Note that email addresses within the outgoing piece of email are “information on its associations” which CC and BCC functionally control the visibility of) however Agrawal does not disclose enabling an options list to appear

Rosenschein discloses right clicking to enable an option list which provides functionality to appear regarding a document such as email (Col 2, lines 9-18) and it would have been obvious to one of ordinary skill in the art to provide user functionality through the option lists in order to provide user functionality. Additionally note Agrawal provides the functionality of showing and hiding associations. (Col 7, lines 53-56)

Regarding claim 4, Agrawal as modified discloses the reply email showing the associated e-mails to a recipient when the show associations option is selected (Col 7, lines 53-56 Note the logic to switch views would inherently be able to toggle views based upon selected view).

Regarding claim 5, claim 5 is rejected for substantially the same reason as claim 4 above.

Regarding claim 6, Agrawal discloses providing a collapsibility and expandability feature for the associated group (Abs Note that the implementation uses folders which are inherently collapsible and expandable).

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Regarding claim 8, Agrawal discloses the step of providing e-mail operations for performing on the associated group of e-mails (Col 7, lines 50-56 Note that Agrawal pertains to an e-mail inbox view which would inherently provide e-mail operations to be performed).

Regarding claim 15, Agrawal discloses an e-mail system (Col 7, lines 50-56) comprising:

and an associate feature for providing interactive e-mail organization capabilities to the user by organizing e-mail messages according to user input to form at least one of an associated group of e-mails or an associated e-mail-to-topic group in at least one of the user's mailboxes (Col 1, line 66 – Col 2, line 3 or Col 2, lines 42-44), and automatically associating a second email to the at least one first email from the associated group.

(Col 1, line 65 - Col 2, line 11 Note that in this embodiment documents for training must be attributed to profiles and if the user provides two documents for training, upon adding the second it will be associated with the first, Also note the MPEP provides language which provides an automatic and manual process are patently indistinguishable –

MPEP 2144.04 [R-6] III regarding *en re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194)

a reply email created for at least one of the associated group of e-mails, said reply email being configured to show or hide associations on its associations to a recipient.

(While Agrawal does not specifically disclose a show or hide associations list regarding outgoing mail, CC - or carbon copy and BCC - or blind carbon copy are well known in the art at the time of the invention which show or hide other email addresses associated

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with the outgoing mail and it would have been obvious to one of ordinary skill in the art at the time of the invention to use such email fields. Note that email addresses within the outgoing piece of email are “information on its associations” which CC and BCC functionally control the visibility of

Agrawal does not disclose an options list with respect to each e-mail message, said options list comprising said associate feature.

Rosenschein discloses right clicking to enable an option list which provides functionality to appear regarding a document such as email (Col 2, lines 9-18) because GUI setup is arbitrary inasmuch as the overlying GUI can be set up in any configuration without modification to the underlying functionality and Rosenschein displays options lists as a well-known and easy to understand method for providing underlying functionality within a GUI, it would have been obvious to one of ordinary skill in the art to provide user functionality such as the associate function of Agrawal in an options list (Col 2, lines 8-11).

Regarding claim 16, Agrawal does not disclose an options list with respect to each e-mail message, said options list comprising said associate feature,

Rosenschein discloses right clicking to enable an option list which provides functionality to appear regarding a document such as email (Col 2, lines 9-18) and it would have

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been obvious to one of ordinary skill in the art to provide user functionality such as the associate function of Agrawal (Col 2, lines 8-11).

Regarding claim 18, Agrawal discloses the associated e-mail-to-topic group being formed by creating a user-defined discussion topic heading (Col 1, line 66 - Col 2, line 3) While Agrawal does not disclose causing the options list to appear with respect to at least one e-mail message, selecting the associate feature from said options list, and indicating the discussion topic heading, wherein the at least one e-mail is caused to be automatically associated to the discussion topic to form the associated e-mail-to-topic group and said discussion topic heading appears as an additional field in said at least one e-mail message.

Rosenschein discloses right clicking to enable an option list which provides functionality to appear regarding a document such as email (Col 2, lines 9-18) and it would have been obvious to one of ordinary skill in the art to provide user functionality such as the associate function of Agrawal (Col 2, lines 8-11). Additionally, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the discussion topic or related information as a field within the document to facilitate indexing and other forms of easy organization.

Regarding claim 20, Agrawal discloses an auto-process feature for automatically parsing a received e-mail to search for an existing discussion thread, wherein if an

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existing discussion thread is found, the received e-mail is automatically associated to the discussion thread (Col 2, lines 42-44).

3. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Agrawal in further view of Kekic et al. (US 5,999,179) hereafter Kekic.

Regarding claim 7, Agrawal does not disclose providing graphical indicators showing when the associated group is expanded or collapsed, however expandable and collapsible folder icons associated with folders are well known to one of ordinary skill in the art at the time of the invention as can be demonstrated by Kekic Col 23, lines 65-67 and it would have been obvious to one of ordinary skill in the art to indicate an open or closed group to further facilitate ease of use.

4. Claims 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agrawal. In view of "Shared Folders: Your Online Conference Room" by Doug Anderson, hereafter Anderson and in further view of Microsoft Outlook 2003 Advanced Information Management." PC Today, by Jennifer Farwell hereafter "Farwell"

Regarding claim 9, Agrawal discloses a method for organizing e-mail messages (Abs) comprising the steps of:
associating at least one e-mail message to the user-created discussion topic via user-

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enablement of an association option to form an associated e-mail-to-topic group (Col 1, line 66—Col 2, line 3)

Agrawal does not disclose creating a user-defined discussion topic heading, said discussion topic heading appearing as an entry in at least one of a user's mailboxes however it would have been obvious to one of ordinary skill in the art at the time of the invention to name the folders as created by the implementation of Agrawal by data pertinent to its contents such as discussion topics (as per common folder naming convention) in order to efficiently organize the user's inbox. In addition the disclosure of Anderson makes reference to global email folders based on projects. (Pg 1, ¶3 – Pg 2, ¶ 1) Note the basis of each folder is on a user-defined conversation (in the example the conversation was on various projects) It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Agrawal with the teachings of Anderson in order to support global conversation topics and project repositories for easy access and readability.

In addition, Agrawal discloses a normal and category-based view (Col 7, lines 53-56) where associations are shown or hidden. In the combination mentioned above, all users would have the same functionality within their inboxes and thus would all have the same option to show or hide associations.

Agrawal also does not specifically disclose selecting whether to show a user-defined discussion topic and related email to a recipient, however Farwell discloses such a limitation (Section: "Choose A Category") Note that categories are shown to recipients of the email message and outlook provides the ability to toggle the association. In

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addition, the category view allows the recipient to sort emails based on category and doing so displays at least the one email sent by the original user which is related to the defined category (along with any other emails of the same category that appear within the recipient's mailbox.) Because both references deal with the organization of email, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Farwell with the teachings of Agrawal as modified in order to provide another way of organizing a user's email inbox.

Regarding claim 10, claim 10 is rejected for substantially the same reason as claim 2 above.

Regarding claim 11, claim 11 is rejected for substantially the same reason as claim 3 above.

Regarding claim 12, claim 12 is rejected for substantially the same reason as claim 4 above. Additionally note a 'normal inbox view' does not include association topics as is standard in the art at the time of the invention.

Regarding claim 13, claim 13 is rejected for substantially the same reason as claim 12 above.

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Regarding claim 14, claim 14 is rejected for substantially the same reason as claim 6 above.

Response to Amendment

Regarding applicant's arguments filed 11/06/2008, the arguments are considered but are not deemed to be persuasive.

Specifically, applicant's argument that Agrawal does not associate emails directly with each other is not persuasive as the claimed language does not require "direct association," but instead only that one email is associated with another via a gui.

According to the claimed language of the instant application, there is no requirement that this association be made without a folder structure, just that the association is made via a gui. While the prior art does make use of a folder structure system it shows both manual association and automatic association to other emails both through the folder system and directly by topic.

Regarding applicant's argument that Agrawal does not disclose a show associations and a hide associations for a reply email to control whether the reply email is to show information on its associations, the argument has been considered but is not deemed to be persuasive as CC and BCC are options which show or hide "associations" (as all that is required by the claimed language) in the form of associated email addresses to

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which the message is being sent. CC and BCC are well known email concepts at the time of the invention which show or hide email addresses and it would have been obvious to use such concepts in order to control visibility of recipient email addresses as designed.

Regarding applicant's argument that Farwell does not disclose "controlling whether at least one of the user-defined discussion topic heading and at least one associated email is to be displayed to a recipient of the at least one email message by sending at least one of a show associations option and a hide associations option, The argument is not persuasive as the categories selected are sent to the recipient. The sender is able to "show" or "hide" associations to individual categories by selecting categories which are to be shown. once received by the recipient, they are able to "show" and "hide" associations by switching from normal to category view and selecting individual topics. In this way at least "the user defined topic heading" is shown.

With respect to the remaining claims which are argued to be allowable in view of the arguments given, the argument is not deemed to be persuasive for at least the above reasons.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRUCE A. WITZENBURG whose telephone number is (571)270-1908. The examiner can normally be reached on M-F 9:00 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on 571-272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bruce A Witzenburg/
Examiner, Art Unit 2166

/Etienne P LeRoux/

Primary Examiner, Art Unit 2161